

REMARKS

This communication responds to the Office Action mailed on March 2, 2007. Claims 1, 3, 4, 8, and 13 are amended, claim 2 is canceled, and no claims are added. It is respectfully noted that claims 3-4 have been amended to reflect the cancellation of claim 2, and not for reasons related to patentability. Likewise, claim 13 has been amended to correct a typographical error, and not for reasons related to patentability (to change the term “using” to “having”, which mimics the language used in claim 24, as-filed). As a result, claims 1 and 3-30 are now pending in this Application.

Erroneous Notation of Priority Under 35 U.S.C. 119 on the Office Action Summary Page

The Office Action Summary Page includes an acknowledgement of a claim for foreign priority under 35 U.S.C. 119, and further, that all certified copies of priority documents have been received. However, the Applicant respectfully notes that no priority claim has been made in connection with this Application. Accordingly, it is believed that the section of the Office Action regarding a priority claim is in error.

§102 Rejection of the Claims

Claims 1, 2, 8 and 11 were rejected under 35 USC § 102(e) as being anticipated by Banister (U.S. 6,775,261; hereinafter “Banister”). First, the Applicant does not admit that Banister is prior art, and reserves the right to swear behind this reference in the future. Second, because the Office has not properly established a *prima facie* case of anticipation, the Applicant respectfully traverses this rejection.

The Applicant respectfully notes that independent claims 1 and 8 have been amended to clarify that a group of contiguous channels is selected based on specifying a number of channels, a center channel, and a control channel, and not for reasons related to patentability. That is, the group of contiguous channels is selected based on the specified parameters. A close reading of Banister reveals that this concept is not taught or suggested.

Banister describes initially selecting a block of channels by tuning a receiver to “the appropriate FDMA band, e.g., RF PLL 22 is set to provide a frequency corresponding to the

band of channels under consideration ... such a block of channels might include, for example, channels 313 to 333 ... reception then occurs in this mode ... in order to allow the automatic gain control to settle. *Thereafter*, in step 103 samples are generated by the CDMA receiver portion 60. This situation is illustrated in FIG. 3 ... the receiver has been tuned (using RF PLL 22 in combination with IF PLL 63) so that the center of the CDMA receiver bandwidth 122 coincides with the center of the group of 21 DCCH channels 124.” See Banister Col. 5, line 67 – Col. 6, line 15 (emphasis added). Thus, Banister does not operate to specify a center channel and control channel – only the reception frequency. See also Banister at Col. 2, line 62 – Col. 3, line 6.

It is respectfully noted that anticipation under 35 USC § 102 requires the disclosure in a single prior art reference of each element of the claim under consideration. See *Verdegaal Bros. V. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987). It is not enough, however, that the prior art reference discloses all the claimed elements in isolation. Rather, “[a]nticipation requires the presence in a single prior reference disclosure of each and every element of the claimed invention, *arranged as in the claim*.” *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)) (emphasis added). “The *identical invention* must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989); MPEP § 2131 (emphasis added).

Since Banister does not teach specifying the number of channels, the center channel, and the control channel, and then selecting the contiguous group of channels based on the specified parameters, what is disclosed by Banister is not identical to the subject matter of the embodiments claimed in independent claims 1 and 8, and thus, the rejection of claims 1, 8, and 11 under § 102 is improper (claim 2 has been canceled, and the rejection of this claim is therefore moot). Reconsideration and allowance are respectfully requested.

§103 Rejection of the Claims

Claims 3-4 were rejected under 35 USC § 103(a) as being unpatentable over Banister in view of Van De Berg (U.S. 5,907,812; hereinafter “VanDeBerg”). Claims 5-6, 10, 16, 21 and 25 were rejected under 35 USC § 103(a) as being unpatentable over Banister in view of Kong et al. (U.S. 2004/0192208A1; hereinafter “Kong”). Claims 7, 12, 18 and 23 were rejected under 35 USC § 103(a) as being unpatentable over Banister in view of Kim et al. (U.S. 2003/0087645A1; hereinafter “Kim”). Claims 13, 17, 19-20, 22, 24, and 26-27 were rejected under 35 USC § 103(a) as being unpatentable over Banister in view of Saunders et al. (U.S. 2004/0142696A1; hereinafter “Saunders”). Claims 28-30 were rejected under 35 USC § 103(a) as being unpatentable over Banister in view of Saunders and Banker et al. (U.S. 5,485,221 A; hereinafter “Banker”).

The Applicant does not admit that VanDeBerg, Kong, Kim, Saunders, or Banker are prior art, and reserves the right to swear behind these references in the future. And, since a *prima facie* case of obviousness has not been established as required by M.P.E.P. § 2142, the Applicant respectfully traverses this rejection.

The Examiner has the burden under 35 U.S.C. § 103 to establish a *prima facie* case of obviousness. *In re Fine*, 837 F.2d 1071, 1074, 5 U.S.P.Q.2d (BNA) 1596, 1598 (Fed. Cir. 1988). The M.P.E.P. contains explicit direction to the Examiner in accordance with the *In re Fine* court:

In order for the Examiner to establish a *prima facie* case of obviousness, three base criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *M.P.E.P.* § 2142 (citing *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d (BNA) 1438 (Fed. Cir. 1991)).

The requirement of a suggestion or motivation to combine references in a *prima facie* case of obviousness is emphasized in the Federal Circuit opinion, *In re Sang Su Lee*, 277 F.3d 1338; 61

U.S.P.Q.2D 1430 (Fed. Cir. 2002), which indicates that the motivation must be supported by evidence in the record.

No proper *prima facie* case of obviousness has been established because (1) the proposed combinations do not teach all of the limitations set forth in the claims, (2) there is no motivation to combine the references, and (3) the proposed combinations provide no reasonable expectation of success. Each of these points will be detailed below.

The proposed combinations will not render all claimed elements: As noted above, Banister does not teach specifying the number of channels, the center channel, and the control channel, and then selecting a contiguous group of channels based on the specified parameters. In addition, the Office admits that Banister “is silent on a signed extension channel offset.”

The Office goes on to assert that “Saunders teaches a transmission scheme wherein a number of channels are scanned ... a burst containing a series of +/- ones frequencies (i.e., channels), which read on signed extension channels.” A close reading of Saunders reveals this is not the case.

The cited portion of Saunders teaches that coarse frequency estimation is used to reduce frequency offset (i.e., the frequency offset of the local oscillator at the receiver), and that a beacon preamble burst includes a “clear channel carrier portion 281 ... followed by a field 282 containing an alternating series of ± 1 's ... a remote site will proceed to transmit back to the master site a response burst containing only the carrier it has detected in the beacon preamble.” See Saunders, paras. [0032] and [0136]. It is respectfully noted that neither of these concepts have anything to do with the signed extension channel offset claimed by the Applicant. See, e.g., Application, paras. [0017] and [0019]. Thus, no combination of Banister and Saunders can be applied to render independent claims 13, 19, 24, and 28 as obvious. VanDeBerg, Kong, Kim, and Banker fail for the same reason, and the Office makes no assertion with respect to these references to remedy the deficiency.

There is no motivation to combine the references: The claims are also nonobvious because the test for obviousness under § 103 must take into consideration the invention as a whole; that is, one must consider the particular problem solved by the combination of elements that define the invention. See *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143, 227

U.S.P.Q. 543, 551 (Fed. Cir. 1985) (emphasis added). References must be considered in their entirety, including parts that teach away from the claims. See MPEP § 2141.02.

No proper *prima facie* case of obviousness has been established because both Banister and Vandenberg teach away from the combinations suggested. That is, Banister and VanDeBerg begin their processes with a fixed group of channels that is selected without regard for the number of channels, the center channel, and the control channel. This is shown in Banister with respect to the “block of channels”, and in VanDeBerg, with respect to “fixed radio channels C11, C12, ..., C125 ...”. See Banister, Col. 6, lines 3-6; and VanDeBerg, Col. 7, lines 49-51. Further, VanDeBerg teaches away from any overlap with a legacy channel, as claimed by the Applicant, because “the second system now will scan the radio frequency band R to find a part ... not disturbed by a transmission of the first system.” See VanDeBerg, Col. 7, lines 56-60.

The proposed combinations provide no reasonable expectation of success: Even if the proposed combinations are made, no reasonable expectation of success arises. This is because neither Banister, nor Saunders, no VanDeBerg (nor any other cited reference) provides selection of a group of contiguous channels based on a specified number of channels, center channel, and control channel. Further, the frequency offset described by Saunders is related to the frequency offset of the local oscillator at the receiver (which is variable, and has to be estimated), and not to the fixed signed extension channel offset claimed by the Applicant. Thus, one of ordinary skill in the art would not expect that combining these references would produce the claimed embodiments – no proper selection of a contiguous communication channel group would result.

In summary, the references neither teach nor suggest the existence of “first specifying a number of channels, a center channel, and a control channel; and second selecting a group of contiguous communications channels including the number of channels, the center channel, and the control channel”, or the existence of a “signed extension channel offset” as claimed by the Applicant. Thus, independent claims 1, 8, 13, 19, 24, and 28 are nonobvious. All dependent claims are also nonobvious, since any claim depending from a nonobvious independent claim is also nonobvious. See M.P.E.P. § 2143.03.

Further, there is no motivation to combine the references, and no reasonable expectation of success arises if the proposed combinations are made. Thus, the requirements of M.P.E.P. § 2142 have not been satisfied; and a *prima facie* case of obviousness has not been established

with respect to the Applicant's claims. It is therefore respectfully requested that the rejection of claims 1 and 3-30 under 35 U.S.C. § 103 be reconsidered and withdrawn.

Allowable Subject Matter

Claims 9, 14 and 15 were objected to as being dependent upon a rejected base claim, but were indicated to be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. However, as all of the claims should already be in condition for allowance according to the discussion above, the Applicant respectfully declines to amend these claims at this time.

CONCLUSION

The Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone the Applicant's attorney at (210) 308-5677 to facilitate prosecution of this Application. If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Reservation of Rights

In the interest of clarity and brevity, the Applicant may not have addressed every assertion made in the Office Action. The Applicant's silence regarding any such assertion does not constitute any admission or acquiescence. The Applicant reserves all rights not exercised in connection with this response, such as the right to challenge or rebut any tacit or explicit characterization of any reference or of any of the present claims, the right to challenge or rebut any asserted factual or legal basis of any of the rejections, the right to swear behind any cited reference such as provided under 37 C.F.R. § 1.131 or otherwise, or the right to assert co-ownership of any cited reference. The Applicant does not admit that any of the cited references or any other references of record are relevant to the present claims, or that they constitute prior art. To the extent that any rejection or assertion is based upon the Examiner's personal

knowledge, rather than any objective evidence of record as manifested by a cited prior art reference, the Applicant timely objects to such reliance on Official Notice, and reserves all rights to request that the Examiner provide a reference or affidavit in support of such assertion, as required by MPEP § 2144.03. The Applicant reserves all rights to pursue any cancelled claims in a subsequent patent application claiming the benefit of priority of the present patent application, and to request rejoinder of any withdrawn claim, as required by MPEP § 821.04.

Respectfully submitted,

ADRIAN P. STEPHENS

By his Representatives,
SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.
P.O. Box 2938
Minneapolis, Minnesota 55402
(210) 308-5677

By / Mark V. Muller /
Mark V. Muller
Reg. No. 37,509